

REMARKS

Interview

Applicants have reviewed the Interview Summary. However, it is not clear from the Interview Summary as what amendments need to be made to overcome the 35 U.S.C. § 112, second paragraph rejection, since the Office Action, dated May 9, 2008, does not contain a § 112, second paragraph, rejection.

Status of the Claims

Claims 1, 3-5, 9-11, and 14-19 are pending. Claims 2, 6-8, 12, and 13 have been canceled without prejudice or disclaimer of the subject matter claimed therein. Claims 10, 11, and 15-19 are withdrawn from consideration as being directed to a separate invention. Claims 1, 3-5, 9, and 14 are currently under examination.

Claims 1, 5, and 19 have been amended. Claim 1 has been amended to delete redundant phrases. Claims 5 and 19 have been amended for consistency in the format of the claim. The amendments to the claims do not include prohibited new matter.

Rejoinder

Applicants respectfully point out that MPEP 821.04(b) requires that once a product claim is found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim must be rejoined. Thus, once a claim directed to a product (claims 1, 3-5, 9, and 14) is found allowable, withdrawn method claims (claims 10, 11, and 15-19) which depend from or otherwise include all the limitations of the allowed claim must be rejoined.

Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph

Claims 1, 3-7, 9, and 14 are rejected under 35 U.S.C. § 112, first paragraph as allegedly only enabling for a limited class of compounds of formula (1).

The Office Action alleges that the claims encompass a large number of compounds and the specification only enables a limited class of compounds of formula (I). Applicants

respectfully submit that the claims, as they stand, are directed to compounds having formula (I). Moreover, moieties “A”, “B”, and “C” in formula (I) have specific structures. Thus, the claims only encompass compounds having the recited structure.

The specification enables the compounds encompassed by the claims. As shown in the table on page 25 of the specification, the compounds encompassed by the claims have favorable M40 profiles. Also, on page 25, lines 13-16, the specification states that these compounds have good activity against a broad range of Gram-positive pathogens. Moreover, the specification on page 75, lines 30-32 and on page 76, lines 9-10 confirm that these compounds are useful as antibacterial agents.

The Office Action alleges that there is no evidence that the generic statements found on page 76 pertain to the elected compounds. However, when these statements are read in conjunction with the statements cited above, there is no doubt that these statements relate to the elected compounds.

Further, Applicants respectfully point out that the initial burden is on the Examiner to provide a reasonable explanation as to why the scope of protection provided by the claim is not adequately enabled by the disclosure. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Moreover, the court in *In re Marzocchi* stated that it is incumbent upon the Patent Office to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Office Action has not provided a reasonable explanation as to why the scope of the claims is not adequately enabled by the specification and has not provided evidence showing that the claims are not enabled by the specification. Also, the Office Action has not provided a reasonable explanation as to why the statements in the specification do not pertain to the elected compounds.

Rejection of the Claims Under 35 U.S.C. § 103(a)

Claims 1, 3-7, 9, and 14 are rejected 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 2001094342 (Lee).

Lee does not teach or suggest the claimed invention because Lee only discloses phenyl

oxazolidinone derivatives substituted with pyridine or pyrimidine derivatives at the 4-position of the phenyl ring. The phenyl oxazolidinone derivatives of Lee do not encompass pyridine substituted compounds bearing a carbon-linked heterocyclic substituent. Moreover, there is no reason to make the necessary changes to the compounds of Lee to arrive at the claimed invention with reasonable expectation of success because Lee only teaches that when the R4 substituent on the pyridinyl ring contains a heterocyclic group, it must either be directly attached via a ring nitrogen or must be linked to the pyridine ring by at least one carbon atom or an oxygen atom. Thus, Lee neither teaches nor suggests the claimed invention.

Double Patenting

A. Claims 1, 3-7, 9, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application Nos. 11/569,150; 11/569,148; 11/569,408; 11/569,208; 10/506,020; and 10/536,687.

Applicants respectfully request that this rejection be held in abeyance until allowable subject matter has been indicated.

B. Claims 1, 3-7, 9, and 14 are allegedly rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,192,947.

Claims 1, 3-7, 9, and 14 are also allegedly rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-17 of U.S. Patent No. 7,192,974.

Applicants respectfully request clarification of these rejections because the claims of the present invention are allegedly rejected as being obvious over and as being the same invention as that of claims 1-17 of U.S. Patent No. 7,192,974. It is not clear how the claimed invention of the present application can be both obvious over and the same as the claimed invention of U.S. Patent No. 7,192,974.

Once these rejections have been clarified, Applicants can then provide an appropriate response.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **August 11, 2008**
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